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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,645	09/25/2003	Wenge Xie	MEMORY-33	4450

24980 7590 12/11/2006

MILLEN, WHITE, ZELANO & BRANIGAN, PC  
2200 CLARENDON BLVD  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER

COVINGTON, RAYMOND K

ART UNIT PAPER NUMBER

1625

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/669,645

**Applicant(s)**

XIE ET AL.

**Examiner**

Raymond Covington

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7,12,15,21-39 and 48-66 is/are pending in the application.
- 4a) Of the above claim(s) 23-37,48-53 and 55-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,11,12,14,15,19,21,22,38,39 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,2,6,7,11,12,14,15,19,21-39 and 48-66 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/25/04,6/16/04,10/19/04,2/16/05,7/6/05,7/20/05,3/24/06,6/09/06.

### **DETAILED ACTION**

Applicants' response to the restriction requirement electing group I with the further election of the species of example 11 is noted. No traverse is noted and the restriction is maintained for reasons of record.

Accordingly, claims 11,14,19,23-37,48-53 and 55-66 have been withdrawn from consideration as being directed to non-elected subject matter.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,6,7,11, 12, 14, 15, 19, 21,22, 38, 39 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al WO 02/100358.

Walker et al teach corresponding azabicyclo indazole compounds. X is O, R<sub>1</sub> is hydrogen, the azabicyclo is formula I, W<sup>o</sup> is formula where V-Y-Z is N-N-C, W is CR<sub>6</sub> is H and W<sup>o</sup> is substituted with lower cycloalkyl (read cyclopropyl).

Walker et al differs in that the azabicyclo moiety is attached at the 5 position instead of at the 3, 4 or 7 position as recited in applicants' claims.

However, the compounds of Walker et al are closely related structural isomers of those claimed. The Courts have conclusively established, per *In re Norris*, 84 USPQ 458, that structural isomers have defined predictable physical properties, and novel and useful chemical compound which is isomeric with compounds of the prior art are not patentable. Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. *In re Norris*, 84 USPQ 458 (1950).

Further as to the HCL salt of claim 38, see page 25 line 26.


No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (571) 272-0681. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie at telephone number (571) 272-0681.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thomas McKenzie  
SPE  
Art Unit 1625

*RKC*

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